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10/551,863

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Barbara Dold

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SUITE 1201

NEW HAVEN, CT 06510

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

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12/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/551,863 | Applicant(s) DOLD, BARBARA | |
| | Examiner GINA C. YU | Art Unit 1611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of response filed on August 17, 2009. No amendment has been made, and claims 33 -62 are pending.

All claim rejections as indicated in the previous Office action dated May 15, 2009 are maintained for reasons of record.

Claim Rejections - 35 USC § 112 (MAINTAINED)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 51 requires a preparation of its base claim avoid of wax, fat and oil. the claim is rendered vague and indefinite because claim 33, the base claim on which claim 51 depends, requires volatile silicone oil.

Claim Rejections - 35 USC § 102 (MAINTAINED)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 33, 39, 40, 42-50, 52, 54-56, 60, 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Leverett (US 6132739).

Leverett discloses a water-in-oil emulsion makeup foundation comprising an aqueous phase comprising C10 polycarbomyl polyglyceryl ester, a polyurethane copolymer; an emulsified phase comprising cyclomethicone (volatile silicone), metal oxides (pigments), and optionally acrylates copolymer suspending agent (filler). See

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example 2; instant claims 33, 39, 40, 42, 47, 48, 49, 60, 61. The composition also contains glycerin humectant, meeting instant claims 43, 44, 50. The humectant and plant extracts as antioxidant meet instant claims 50, 54, and 55. The volatile silicone oil phase contains dimethicone copolyol emulsifier, meeting instant claim 52. The reference teaches the aqueous phase containing film-forming polymer is individually mixed until homogenous before mixed with other phases, thus meeting instant claim 56. Applicant's "light diffusing pigments" of claim 45 and 46 are considered met by the prior art product which contains yellow, black, and red iron oxides coated with magnesium myristate.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett as applied to claims 33, 39, 40, 42-50, 52, 54-56, 60, 61 as above, and further in view of the teaching of the reference.

Although Example 2 of the reference uses 1 % by weight of the hydrophilic film forming copolymer, the reference teaches up to 8 wt % of hydrophilic film former can be used. See col. 5, lines 10-16; instant claims 58, 59. The prior art makeup foundation is said to have enhanced transfer resistance.

Claims 34-38, 41, 53, 57, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett as applied to claims 33, 39, 40, 42-50, 52, 54-56, 58-61 as above, and further in view of Hanna et al. (US 5879668).

Leverett teaches polyurethanes, acrylates, and methacrylate are among the suitable hydrophilic film formers to make the W/O transfer-free makeup foundation, and

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the reference generally teaches the film-formers may be combined. The reference does not does not particularly mention combining polyurethane and acrylate polymers.

Hanna also teaches a waterproof, long wear and transfer resistance O/W emulsion cosmetics comprising water-soluble or -dispersible film-forming polymers. Particularly mentioned are polycarbamyl polyglycol ester (a polyurethane) or ammonium acrylate copolymer, sodium polymethylacrylate, etc. See col. 5, lines 4 - 22. The reference states, "mixtures of such polymers may be used" and also teaches acrylic polyurethanes. Using the water-soluble or dispersible polymers in the range of 0.1-10 wt % is taught. Useful emulsifiers for the prior art emulsion include glyceryl stearate, alkyl dimethicone copolyol, polyglyceryl -4 isostearate, etc. See col. 4, lines 28 - 49; instant claim 53. Hanna further teaches adding light diffusing particles (nylon-12 particles) for camouflaging fine lines of skin and improving the skin feel when the product is applied to the skin. See col. 6, lines 3 - 13.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Leverett by selecting the water-soluble or water-dispersible film-forming copolymers, i.e., polycarbamyl polyglycol ester, or ammonium acrylate copolymer, and sodium polymethylacrylate, among the suitable film-formers as motivated by Hanna, because Leverett teaches polyurethanes and acrylate polymers are suitable film-formers for the invention; and Hanna specifically teaches a combination of polyurethanes with acrylate polymers or acrylic polyurethane copolymer to make a transfer-resistant make-up in a form of water-in-oil emulsion. The skilled artisan would have had a reasonable expectation of successfully producing a stable transfer-resistant W/O cosmetic with a similar or enhanced efficacy.

With respect to the process claim of claim 62, it is well settled in patent law that selection of any order of mixing ingredients is prima facie obvious. See In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). See also Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). In this case, Leverett teaches adding hydrophilic film formers in an aqueous phase which forms the interior water phase before the aqueous phase is mixed with the volatile silicone phase comprising the pigments. The instant claim requires thickeners and film-forming polymers be added after the homogenization of the volatile silicone and water phase, which also results in a W/O emulsion comprising the polymers in the water phase. In view of the holding of the precedents, altering the sequence of the adding the ingredients from the prior art is prima facie obvious.

Response to Arguments

Applicant's arguments filed on August 17, 2009 have been fully considered but they are not persuasive.

With respect to the 35 U.S.C. § 112, second paragraph rejection, applicant asserts that the component in claim 33 is “volatile silicone” and not “volatile silicone oil”, referring to paragraphs [0045-50] of the specification. In paragraph [0049], the specification states, “[b]y virtue of that structure and the proportion of film-forming polymer combination, it is possible to dispense with the normal use of fats, waxes and oils (in the form of triglycerides, liquid fatty acid esters or mineral oils), as are otherwise

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necessary”. Examiner views such statement falls short of a clearly defining what applicant means by the term “oil” in the claim language. Particularly in this case, a clear definition is necessary to define the scope of the claim protection because one of ordinary skill typically classify volatile silicones as suitable cosmetic oils. See, for example, US 6616936 B1 or US 6703029 B1. In this case, there is no disclosure in the specification as to what applicant means to include or exclude by the term "oil", and without such definition one of ordinary skill in the art would have considered the term includes silicone oil. Since "volatile silicone" includes what are known as conventional cosmetic oil (e.g., cyclomethicone, etc.), the skilled artisan would have also considered the “at least one volatile silicone” means, or encompasses, silicone oil compounds.

Regarding the rejection made under 35 U.S.C. § 102 (b), applicant asserts the Leverett does not anticipate the preparation of claim 33 without clearly pointing out distinction between the prior art and the claimed invention. The fact that Leverett is drawn to a “water-in-oil” emulsion alone does not distinguish the prior art from the claimed composition. The rejected claims do not require the volatile silicone phase be the discontinuous or continuous phase. The prior art emulsion comprises the same components of claim 33, i.e., a cosmetic emulsion having an aqueous phase comprising a film-forming polymer comprising at least two polymers (i.e., C10 polycarbomyl polyglyceryl ester and a polyurethane copolymer); and an emulsified volatile silicone phase comprising at least one volatile silicone (cyclomethicone), at least one pigment (metal oxides) and optional fillers (acrylates copolymer), emulsified with dimethicone copolyol emulsifier. Applicant refers to paragraphs [0049], [0051], and [0036] without specifically pointing out or explaining how the disclosure therein distinguishes the

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presently claimed invention from the prior art. Examiner maintains the position that the claims are prima facie anticipated by Leverett.

Regarding the rejection made under 35 U.S.C. § 103 (a), applicant also asserts that the obviousness rejections are improper, but does not specifically point out or explain how the claim language patentably distinguishes from the prior art teachings.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Primary Examiner, Art Unit 1611